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| 10/635,919      | 08/06/2003  | Claudius Zeiler      | 5858-00800          | 8849             |

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07/09/2007

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| EXAMINER |
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PRIDDY, MICHAEL B

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| ART UNIT | PAPER NUMBER |
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3733

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07/09/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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|------------------------------|---------------------------------------|--------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/635,919  | <b>Applicant(s)</b><br>ZEILER ET AL. |  |
|                              | <b>Examiner</b><br>Annette R. Reimers | <b>Art Unit</b><br>3733              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a): In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 April 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 17-19, 21, 22 and 29-31 is/are pending in the application.
- 4a) Of the above claim(s) 17-19, 21 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 29-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 19 is rejected under 35 U.S.C. 102(b) as being anticipated by Herzberg (U.S. Patent No. 4,988,350).

Herzberg discloses an implant plate comprising a head-end portion, 25a, and a shaft-end portion, 24, wherein the head-end portion comprises a first head side facing and adapted to bear against the bone, a second head side opposite the first head side, and a pair of parallel-spaced head edge surfaces adjoining lateral extents of the first and second head sides (see figures 17 and 18) wherein the shaft-end portion comprises a first shaft side facing and adapted to bear against the bone, a second shaft side opposite the first shaft side, and a pair of parallel-spaced shaft edge surfaces adjoining lateral extents of the first and second shaft sides (see figures 17 and 18) holes for bone screws, e.g. 26, and at least one raised receiving member, e.g. 126, 126', 126" extending perpendicularly outward from only the second head side, wherein the receiving member has an aperture, e.g. 129, of circular enclosed inner diameter that surrounding a central axis extending substantially parallel to the lateral extents of the first and second head sides, wherein each receiving member has a blunt/rounded

edged aperture, 129, (see figures 17 and 18). A one piece plate cut or punched from a flat metallic strip material having a substantially uniform thickness of 0.5 to 6.5 mm is a product-by process. "Even though product-by-process claims are limited and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on the method of its production. If the product in the product-by-process claim is the same as or obvious from the product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

With regard to the statement of intended use and other functional statements they do not impose any structural limitations on the claims distinguishable over Herzberg, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). In addition, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sioufi (US Patent Number 5,409,489).

Sioufi discloses comprising a head-end portion, 77, and a shaft-end portion, wherein the head-end portion comprises a first head side facing and adapted to bear

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against the bone, a second head side opposite the first head side, and a pair of parallel-spaced head edge surfaces adjoining lateral extents of the first and second head sides (see figures 8a and 8b) wherein the shaft-end portion comprises a first shaft side facing and adapted to bear against the bone, a second shaft side opposite the first shaft side, and a pair of parallel-spaced shaft edge surfaces adjoining lateral extents of the first and second shaft sides (see figures 8a and 8b), holes for bone screws, 85, a raised receiving member, 88, (see figures 8a and 8b), wherein the receiving member has an aperture of circular enclosed inner diameter that surrounding a central axis extending substantially parallel to the lateral extents of the first and second head sides (see figure 8b below), and wherein the receiving member is provided with the aperture by being formed to be an eyelet perpendicular to an outer edge of the head-end portion and having a drill hole (see figures 8a and 8b). Furthermore, an outer edge of the aperture in the receiving member is blunted, rounded, and smoothed on entry and exit side, and all edges and rims intended to contact the flexible fastening member and human tissue are blunted, rounded, and smoothed (see figures 8a and 8b). A one piece plate cut or punched from a flat metallic strip material having a substantially uniform thickness of 0.5 to 6.5 mm is a product-by process. "Even though product-by-process claims are limited and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on the method of its production. If the product in the product-by-process claim is the same as or obvious from the product of the prior art, the claim is unpatentable even though the prior product was made by a

different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

With regard to the statement of intended use and other functional statements they do not impose any structural limitations on the claims distinguishable over Sioufi, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference “teach” what the subject patent teaches, but rather it is only necessary that the claims under attack “read on” something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). In addition, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herzberg (U.S. Patent No. 4,988,350).

Herzberg discloses the claimed invention except for the thickness of the plate member being 0.8 to 3.5mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Herzberg with the

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thickness of the plate member being 0.8 to 3.5mm., since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sioufi (US Patent Number 5,409,489).

Sioufi discloses the claimed invention except for the thickness of the plate member being 0.8 to 3.5mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Sioufi with the thickness of the plate member being 0.8 to 3.5mm., since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herzberg (U.S. Patent No. 4,988,350) in view of Mears (U.S. Patent 4,454,876), previously cited by examiner.

Herzberg discloses the claimed invention except for the plate member being of steel, titanium or titanium alloy. Mears discloses a plate member of steel or titanium alloy and teaches the use of such materials due to their suitable inertness, strength and formability (see column 1, lines 66-67). It would have been obvious to one skilled in the art at the time the invention was made to construct the device of Herzberg with the plate member being of steel, titanium or titanium alloy, in view of Mears, so that the plate member is constructed of a material having suitable inertness, strength and formability.

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sioufi (US Patent Number 5,409,489) in view of Mears (U.S. Patent 4,454,876), previously cited by examiner.

Sioufi discloses the claimed invention except for the plate member being of steel, titanium or titanium alloy. Mears discloses a plate member of steel or titanium alloy and teaches the use of such materials due to their suitable inertness, strength and formability (see column 1, lines 66-67). It would have been obvious to one skilled in the art at the time the invention was made to construct the device of Sioufi with the plate member being of steel, titanium or titanium alloy, in view of Mears, so that the plate member is constructed of a material having suitable inertness, strength and formability.

### ***Response to Arguments***

Applicant's arguments filed April 17, 2007 have been fully considered, but they are not persuasive. Examiner respectfully disagrees with applicant regarding the Herzberg and Sioufi references. Herzberg and Sioufi each disclose a one-piece plate. Applicant is not claiming a unibody construction. Examiner suggests amending the claims to state a monolithic construction. Regarding the plate member having a substantially uniform thickness of 0.5 to 6.5mm, as stated above, a one piece plate cut or punched from a flat metallic strip material having a substantially uniform thickness of 0.5 to 6.5 mm is a product-by process. "Even though product-by-process claims are limited and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on the method of its production. If the product in the product-by-process claim is the same as or obvious



from the product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). The bone facing surface of the head end portion and the bone facing surface of the shaft end portion are "shaped to bear against a surface of an upper head bone and a surface of a proximal upper arm bone." This language is considered functional language. As stated above, with regard to the statement of intended use and other functional statements they do not impose any structural limitations on the claims distinguishable over Herzberg or Sioufi, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). In addition, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Moreover, it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Regarding the tube, hook, or hole, the substantially circular and circumferentially enclosed apertures of Herzberg and Sioufi are capable of receiving a guide wire. If applicant has a particular configuration, then applicant should specifically and structurally claim the particular configuration. As previously stated in the

last office action, both Herzberg and Sioufi each disclose a receiving member disposed to extend substantially parallel to the head end portion and facing away from the bone and parallel to the edge of the head end portion to which the receiving member is closest (see figures 17 and 18 of Herzberg and 8a and 8b of Sioufi).

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette R. Reimers whose telephone number is (571) 272-7135. The examiner can normally be reached on Monday-Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AR



EDUARDO C. ROBERT  
SUPERVISORY PATENT EXAMINER